APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,157	04/24/2001	Yoshihiko Watanabe	35.C15213	3428

			EXAMINER
5514	7590	01/12/2005	HUNTSINGER, PETER K

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/840,157	WATANABE ET AL.
	Examiner	Art Unit	
	Peter K. Huntsinger	2624	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _4/24/01_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _8/20/01_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Priority

1.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Claim Objections

2.   Claim 1 is objected to because of the following informalities: On page 88, line 9,

"usee fee" is misspelled and should be use fee. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-3, 11-14, and 22 are rejected under 35 U.S.C. 102(e) as being

anticipated by Kolls.

Referring to claim 1, Kolls discloses a charging system for charging a use fee for

an application, comprising: a first information processing device including preparation

means for preparing a file by executing the application (system 500 of Fig. 3C, col. 7, lines 6-29); and a second information processing device including charging means for charging said application use fee according to whether the file prepared by said first information processing device is subjected to an output process (transaction control device 108 of Fig. 3C, col. 5, lines 62-67) Preparing a file as disclosed by Kolls includes printing and faxing (col. 6, lines 63-67).

Referring to claim 2, Kolls discloses a system according to claim 1, wherein said output process is the printing process for said file (Fig. 16, col. 35, lines 60-62), and said application use fee is determined according to the number of the printing process of said file (col. 6, lines 63-67).

Referring to claim 3, Kolls discloses a system according to claim 1, wherein said output process is a facsimile transmission process for said file, and said application use fee is determined according to the number transmitted by said facsimile transmission process (col. 6, lines 63-67).

Referring to claim 11, Kolls discloses an information processing apparatus comprising: discrimination means for discriminating whether an output process is executed for a file prepared with an application (Fig. 17, col. 36, lines 54-61); and charging means for charging an application use fee based on the discrimination by said discrimination means (transaction control device 108 of Fig. 3C, col. 5, lines 62-67).

Referring to claim 12, Kolls discloses an apparatus according to claim 11, wherein said charging means calculates said application use fee (col. 28, lines 52-54).

Referring to claim 13, Kolls discloses an apparatus according to claim 12, wherein said output process is a printing process for said file, and said charging means calculates the application use fee based on the number of printing process of said file (col. 6, lines 63-67).

Referring to claim 14, Kolls discloses an apparatus according to claim 12, wherein said output process is a facsimile transmission process for said file, and said charging means calculates the application use fee based on the number of transmissions in said facsimile transmission process for said file (col. 6, lines 63-67).

Referring to claim 22, Kolls discloses a method for controlling an information processing apparatus comprising: a discrimination step of discriminating whether an output process is executed for a file prepared with an application (Fig. 15, col. 36, lines 54-61); and a charging step of charging an application use fee based on the discrimination by said discrimination means (step 60 of Fig. 1, col. 5, lines 19-21).

5.   Claims 1, 3, 11, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuzma.

Referring to claim 1, Kuzma discloses a charging system for charging a use fee for an application, comprising: a first information processing device including preparation means for preparing a file by executing the application (electric sender 240 of Fig. 2, col. 5, lines 9-16); and a second information processing device including charging means for charging said application use fee according to whether the file

prepared by said first information processing device is subjected to an output process (electric stamp counter 206 of Fig. 2, col. 5, lines 31-47).

Referring to claim 4, Kuzma discloses a system according to claim 1, wherein said output process is an e-mail transmission process for said file, and said application use fee is determined according to the data amount transmitted by said e-mail transmission process (col.5, lines 19-47).

Referring to claim 11, Kuzma discloses an information processing apparatus comprising: discrimination means for discriminating whether an output process is executed for a file prepared with an application (scale 205 of Fig. 2, col. 5, lines 28-31); and charging means for charging an application use fee based on the discrimination by said discrimination means (electric stamp counter 206 of Fig. 2, col. 5, lines 31-47).

Referring to claim 12, Kuzma discloses an apparatus according to claim 11, wherein said charging means calculates said application use fee (col. 5, lines 28-29).

Referring to claim 15, Kuzma discloses an apparatus according to claim 12, wherein said output process is an e-mail transmission process for said file, and said charging means calculates the application use fee based on the data amount of the e-mail in said e-mail transmission process for said file (col.5, lines 19-47).

6.   Claims 1, 5, 7, 11, 12, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Crawford.

Referring to claim 1, Crawford discloses a charging system for charging a use fee for an application, comprising: a first information processing device including

preparation means for preparing a file by executing the application (customer computer 50 of Fig. 1, col. 12, lines 49-58); and a second information processing device including charging means for charging said application use fee according to whether the file prepared by said first information processing device is subjected to an output process (online service system 100 of Fig. 1, col. 57, lines 59-61). Preparing a file as disclosed by Crawford includes providing software for the customer to use (col. 12-13, lines 59-67, 1-7).

Referring to claim 5, Crawford discloses a system according to claim 1, wherein said output process is a storage process for said file in another device, and said application use fee is determined according to the destination of storage of said file (col. 58, lines 8-17).

Referring to claim 7, Crawford discloses a system according to claim 1, wherein said application use fee is determined according to date and time at which the output process for said prepared file is executed (col. 30, lines 16-22). The billing of a monthly charge according to Crawford considers the date and time when allowing the customer to access the service.

Referring to claim 11, Crawford discloses an information processing apparatus comprising: discrimination means for discriminating whether an output process is executed for a file prepared with an application (Fig. 18, col.45, lines 22-31); and charging means for charging an application use fee based on the discrimination by said discrimination means (online service system 100 of Fig. 1, col. 57, lines 59-61).

Referring to claim 12, Crawford discloses an apparatus according to claim 11, wherein said charging means calculates said application use fee (col. 58, lines 55-62).

Referring to claim 16, Crawford discloses an apparatus according to claim 12, wherein said output process is a storage process for said file in another device, and said charging means calculates the application use fee according to the destination of storage of said file (col. 58, lines 8-17).

Referring to claim 18, Crawford discloses an apparatus according to claim 12, wherein said application use fee is determined according to date and time at which the output process for said generate file is executed (col. 30, lines 16-22). The billing of a monthly charge according to Crawford considers the date and time when allowing the customer to access the service.

7.   Claims 1, 6, 11, 12, 17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki.

Referring to claim 1, Suzuki discloses a charging system for charging a use fee for an application, comprising: a first information processing device including preparation means for preparing a file by executing the application (information transmission control means 3 of Fig. 10, col. 13, lines 37-42); and a second information processing device including charging means for charging said application use fee according to whether the file prepared by said first information processing device is subjected to an output process (charging means 7 of Fig. 10, col. 14, lines 11-14). The digital information transmitted according to Suzuki contains information and is

considered a file. The transfer of digital information to the customer is considered an application.

Referring to claim 6, Suzuki discloses a system according to claim 1, wherein said application use fee is determined according to a time zone in which the output process for said prepared file is executed (Fig. 15, col. 15-16, lines 63-67, 1-5).

Referring to claim 9, Suzuki discloses a system according to claim 1, wherein said application use fee is determined according to the priority of the output process (col. 14-15, lines 65-67, 1-7).

Referring to claim 11, Suzuki discloses an information processing apparatus comprising: discrimination means for discriminating whether an output process is executed for a file prepared with an application (Fig. 19, col. 23, lines 47-53); and charging means for charging an application use fee based on the discrimination by said discrimination means (charging means 7 of Fig. 10, col. 14, lines 11-14). The digital information transmitted according to Suzuki contains information and is considered a file. The transfer of digital information to the customer is considered an application.

Referring to claim 12, Suzuki discloses an apparatus according to claim 11, wherein said charging means calculates said application use fee (col. 16, lines 8-18). An additional charge is added for copying the digital program, which requires calculation.

Referring to claim 17, Suzuki discloses an apparatus according to claim 12, wherein said application use fee is determined according to a time zone in which the output process for said generate file is executed (Fig. 15, col. 15-16, lines 63-67, 1-5).

Referring to claim 20, Suzuki discloses an apparatus according to claim 12, wherein said application use fee is determined according to the priority of the output process (col. 14-15, lines 65-67, 1-7).

8.   Claims 1, 8, 10, 21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson et al.

Referring to claim 1, Ferguson et al. disclose a charging system for charging a use fee for an application, comprising: a first information processing device including preparation means for preparing a file by executing the application (server hardware 100 of Fig. 1, col. 8, lines 58-67); and a second information processing device including charging means for charging said application use fee according to whether the file prepared by said first information processing device is subjected to an output process (online service, col. 9, lines 2-5).

Referring to claim 8, Ferguson et al. disclose a system according to claim 1, wherein, in case a file is prepared with plural applications provided from a same application provider, said application use fee is discounted (col. 30, lines 31-35).

Referring to claim 10, Ferguson et al. disclose a system according to claim 1, wherein said application use fee is determined according to the cumulative result of the output process for said file (col. 34, lines 20-31).

Referring to claim 11, Ferguson et al. disclose an information processing apparatus comprising: discrimination means for discriminating whether an output process is executed for a file prepared with an application (col. 37, lines 44-52); and

charging means for charging an application use fee based on the discrimination by said

discrimination means (online service, col. 9, lines 2-5).

Referring to claim 12, Ferguson et al. disclose an apparatus according to claim

11, wherein said charging means calculates said application use fee (col. 33, lines 52-

58).

Referring to claim 19, Ferguson et al. disclose an apparatus according to claim

12, wherein, in case a file is prepared with plural applications provided from a same

application provider, said application use fee is discounted (col. 30, lines 31-35).

Referring to claim 21, Ferguson et al. disclose an apparatus according to claim

12, wherein said application use fee is determined according to the cumulative result of

the output process for said file (col. 34, lines 20-31).

Referring to claim 23, Ferguson et al. disclose a computer readable memory

medium storing a program for controlling an information processing apparatus, the

program comprising: a discrimination code of discriminating whether an output process

is executed for a file prepared with an application (metering tool 726 of Fig. 7, col. 37,

lines 43-52); and a charging code of charging an application use fee based on the

discrimination by said discrimination means (Fee Setter 722 of Fig. 7, col. 31-32, lines

61-67, 1-4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (703)306-4088. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

JOSEPH MANCUSO
PRIMARY EXAMINER